



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,324	03/10/2005	Khalil Hanna	0513-1142	3505
466 7590 06/04/2008 YOUNG & THOMPSON 209 Madison Street Suite 500 ALEXANDRIA, VA 22314			EXAMINER DEAK, LESLIE R	
			ART UNIT 3761	PAPER NUMBER
			MAIL DATE 06/04/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/527,324

**Applicant(s)**

HANNA, KHALIL

**Examiner**

LESLIE R. DEAK

**Art Unit**

3761

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 March 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 20 March 2008 has been entered.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 11-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,629,533 to Webb et al in view of US 2003/0018291 to Hill et al.

In the specification and figures, Webb discloses the invention substantially as claimed by applicant. With regard to claim 11, Webb discloses a punctum plug comprising an elongate body 512 with a longitudinal axis, an elliptical collar 518/538 perpendicular to the elongate body, wherein the elongate body is attached to the collar at one end portion (see FIGS 6a, 6b). The elongate body comprises a second end portion comprising branch 538, one end of which extends away from the collar.

Webb fails to disclose that the second end of the elongate body comprises two branches that extend in a direction away from the collar wherein the branches are elastically connected to the elongate body. Hill discloses an implantable device that comprises at least two branches 22 at a distal end of an elongate body 20 wherein the branches extend in a direction away from the proximal end of the elongate body (see FIGS 1, 3). The arms or branches 22 are elastically connected to the elongate body 22 and after implantation (during implantation, the branches are brought together in an injector apparatus, see Hill paragraph 0029), the branches diverge elastically from one another to anchor the implant in place (see paragraph 0030). All of the claimed elements were known in the prior art, and one having ordinary skill in the art at the time of invention could have combined the elements as claimed by known methods, with no change in their respective functions, and the combination would have yielded nothing more than predictable results. It would one having ordinary skill in the art at the time of invention to replace the single branch disclosed by Webb with the multiple branches disclosed by Hill, since all the elements are known in the art, and such a combination would yield the predictable result of a punctum plug with an elongate body, elliptical collar, and multi-branched anchoring portion in order to anchor the implant in place.

With regard to claims 12, 14, and 17, Webb discloses that the first portion of the elongate body comprises an elliptical cross section (see Webb FIG 6b). Hill illustrates that, in an embodiment, the branches 22 comprise a cross-section substantially equal to half the cross-section of the elongate body (see Hill, FIG 7), suggesting the limitations of the claims.

With regard to claims 13, 15, and 16, Webb illustrates that the collar may be offset relative to the longitudinal axis of the elongate body with a major axis in parallel with the major axis of the elongate body (see Webb FIG 6b).

### ***Response to Arguments***

4. Applicant's arguments with respect to the patentability of the newly presented claims have been considered but are moot in view of the new ground(s) of rejection. Nonetheless, the Examiner will address applicant's arguments that are pertinent to the instantly presented rejection.
5. In response to applicant's argument that Webb and Goode comprise nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Webb, Hill, and Applicant all disclose implantable medical devices that require anchor members to retain the implants in place. The Examiner looked to the various anchoring systems of implantable devices in combining the relative art. Webb and Hill, as well as Applicant, disclose implantable devices with anchoring members. The anchoring members are all directed to solving the same problem—retaining an implant in the desired location. Since the applied art attempts to solve the same problem encountered by applicant, the references are, in fact, analogous to one another and Applicant's invention and properly combined.

6. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that a surgeon, knowing the geometry of the implant, can adjust the angular orientation of the plug around its axis for proper implantation) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LESLIE R. DEAK whose telephone number is (571)272-4943. The examiner can normally be reached on Monday - Friday, 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on 571-272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Leslie R. Deak/  
Primary Examiner  
Art Unit 3761  
2 June 2008